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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/771,095	01/26/2001	David Konetski	16356.578 (DC-02701)	7695
27683 7590 06/12/2007 HAYNES AND BOONE, LLP 901 MAIN STREET, SUITE 3100 DALLAS, TX 75202			EXAMINER DALENCOURT, YVES	
			ART UNIT 2157	PAPER NUMBER
			MAIL DATE 06/12/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/771,095	<b>Applicant(s)</b> KONETSKI ET AL.	
	<b>Examiner</b> Yves Dalencourt	<b>Art Unit</b> 2157	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 March 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 27-52 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 27-52 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

This office action is responsive to amendment filed on 03/29/2007.

#### *Response to Amendment*

The Examiner has acknowledged Applicant's responses.

#### *Response to Arguments*

Applicant's arguments filed on 03/29/2007 have been fully considered but they are not persuasive.

Regarding Applicant's argument (page 5, last paragraph) that Lai's reference does not teach a single computer system that retrieves digital media content, performs a digital rights management function associated with an authorized user, and stores the authorized digital media content. The Examiner respectfully disagrees with Applicant's assertion because Lai clearly discloses a media transcoding engine 106 (fig. 2) that retrieves digital media content, performs a digital rights management function associated with an authorized user, and stores the authorized digital media content as claimed (paragraphs [0030], [0091]. Applicant has not shown how the Lai's reference differs from the claimed invention, except for arguing that Lai does not teach a "**single computer system**", which the Examiner contends that Lai does teach a computer system that reads on the claimed language. Applicant has failed to specifically point out how the language of the claims patentably distinguishes them from the references.

In response to applicants' argument (pages 6 - 8) that there is no suggestion to combine the references, the examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. In *re Nomiya*, 184 USPQ 607 (CCPA 1975). However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosure taken as a whole would suggest to one of ordinary skill in the art. In *re McLaughlin*, 170, USPQ 209 (CCPA 1971). references are evaluated by what they suggest to one verse in the art, rather than by their specific disclosures. In this case Lai teaches a method for delivering media content over a network to a client, and Platt discloses the idea of allowing a user to create a playlist of stored organized digital media content (col. 1, lines 12 – 67; col. 2, lines 16 – 36; col. 4, lines 4 – 11 and lines 45 - 50) for the purpose of permitting user(s) to select different moods and/or styles (e.g., dance music, classical, big band, country, heavy metal and the like), thereby allowing a playlist that meets user's preferences.

In fact, it appears that Applicants are interpreting the claims very narrow without considering the broad teaching of the reference used in the rejection.

Applicants are reminded that the examiner is entitled to the broadest reasonable interpretation of the claims. Applicants always have the opportunity to amend the claims during prosecution and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. In *re Prater* 162 USPQ 541,550-51 (CCPA 1969).

In view of such, the rejection is maintained as follows:

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 27 – 41 are rejected under 35 U.S.C. 102(e) as being anticipated by Lai et al (US 2004/0193648; hereinafter Lai).

Regarding claims 27, 40, and 46, Lai teaches a computer system and a method comprising a processor and a memory (fig. 2; paragraph [0066]) for retrieving digital media from a content provider (paragraphs [0030], [0067], and [0127]; performing a digital rights management function associated with an authorized user resulting in authorized digital media content (paragraphs [0007], [0141], and [0164]); storing the authorized digital media content on the computer system (paragraphs [0155] - [0159]; and providing the authorized digital media content via a user interface to a thin media client without performing a digital rights management function on the thin media client (paragraphs [0030], [0143]).

Regarding claims 28 and 47, Lai teaches the system and method of claims 27 and 46, wherein the computer system comprises a personal computer (viewer client 102, fig. 1; paragraphs 0085 - 0089).

Regarding claims 29 and 48, Lai teaches the system and method of claims 27 and 46, wherein the content provider comprises a laptop computer (paragraphs 0085 - 0089).

Regarding claims 30 and 49, Lai teaches the system and method of claims 27 and 46, wherein the content provider comprises a server reachable by the computer system over a network (paragraphs 0085 - 0089).

Regarding claims 31 and 51, Lai teaches the system and method of claims 27 and 46, wherein the content provider comprises a local input device (paragraphs 0085 - 0089).

Regarding claims 32 and 33, the Examiner takes Official Notice that having a content provider, which comprises a USB, and a CD-ROM is well known in the art.

Regarding claims 34 and 50, the Examiner takes Official Notice that using a Bluetooth to receive authorized digital media content is well known in the art.

Regarding claims 35 and 36, Lai teaches the system of claim 27, wherein the thin media client comprises an audio client; and wherein the digital media content comprises an audio file (paragraphs [0005], and [0087] – 0088)).

Regarding claims 37 and Lai teaches the system and method of claims 2 and 16, wherein the digital media content comprises realtime audio information (paragraphs [0010], [0014], [0086], and [0138]).

Regarding claims 38 – 39, Lai teaches the system and method of claims 2 and 15, wherein the thin media client comprises a video client, and wherein the digital media content comprises video information; and wherein the thin media client comprises an image client, and wherein the digital media content comprises image information (paragraphs [0005] and [0170]).

Regarding claim 41, Lai teaches the system of claim 40, wherein the organization functions allow a user to set preferences associated with a client (paragraph [0099]).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 42 – 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lai et al (US 2004/0193648; hereinafter Lai) in view of John C. Platt (US 6,987,221; hereinafter Platt).

Regarding claim 42, Lai teaches substantially all the limitations in claim 40, but fails to specifically teach that the organization functions allow a user to create playlist of stored organized digital media content.

However, Platt teaches an analogous auto playlist generation with multiple seed songs, which allows a user to create a playlist of stored organized digital media content (col. 1, lines 12 – 67; col. 2, lines 16 – 36; col. 4, lines 4 – 11 and lines 45 - 50).

Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Lai by incorporating an organization functions that allow a user to create playlists of stored organized digital media content as evidenced by Platt for the purpose of permitting user(s) to select different moods and/or styles (e.g., dance music, classical, big band, country, heavy metal and the like), thereby allowing a playlist that meets user's preferences.

Regarding claim 43, Lai and Platt teach all the limitations in claim 40, and Platt further teaches that the organization functions allow a user to manage a favorites list of organized digital media content (col. 1, lines 12 – 67; col. 2, lines 16 – 36; col. 4, lines 4 – 11 and lines 45 - 50). The motivation in claim 41 also applied for claim 43.

Regarding claim 44, Lai and Platt teach all the limitations in claim 40, and Platt further teaches that the organization functions allow a user to manage the amount of organized digital media stored on the computer system (col. 1, lines 12 – 67; col. 2,



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lines 16 – 36; col. 4, lines 4 – 11 and lines 45 - 50). The motivation in claim 41 also applied for claim 44.

Regarding claim 45, Lai and Platt teach all the limitations in claim 40, and Platt further teaches that the organization functions allow a user to select digital media content to be retrieved (col. 1, lines 12 – 67; col. 2, lines 16 – 36; col. 4, lines 4 – 11 and lines 45 - 50). The motivation in claim 41 also applied for claim 45.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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### **Contact Information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yves Dalencourt whose telephone number is (571) 272-3998. The examiner can normally be reached on M-TH 7:30AM - 6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571) 272 4001. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

June 02, 2007

  
YVES DALENCOURT  
PRIMARY EXAMINER  
TECHNOLOGY CENTER 2100